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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,850	02/26/2007	Jae-Yeol Park	7120P001	2288

7590 12/22/2009  
Blakely, Sokoloff, Taylor & Zafman  
12400 Wilshire Boulevard  
7th Floor  
Los Angeles, CA 90025

EXAMINER
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SHEEHAN, JOHN P

ART UNIT	PAPER NUMBER
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1793

MAIL DATE	DELIVERY MODE
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12/22/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/576,850	<b>Applicant(s)</b> PARK ET AL.	
	<b>Examiner</b> John P. Sheehan	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I claims 1 to 3 in the reply filed on October 9, 2009 is acknowledged.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted known prior art disclosed in the specification at page 2, lines 5 to 32 and page 4, lines 5 to 9 in view of any one of Tsukada et al. (Tsukada '636, US Patent No. 5,800,636, cited by the Examiner), Mitani et al. (Mitani '706, US Patent Application Publication 2003/0047706, cited by the Examiner) or Moro (Moro '280 US Patent Application Publication No. 2002/0014280, cited by the Examiner).

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The specification discloses that it is well known in the prior art to make powder cores using pure iron powder (page 2, lines 5 to 15), MPP powder (page 2, lines 16 to 19), high flux powder (page 2, lines 20 to 23) and Sendust powder (page 2, lines 24 to 32). The specification also discloses that the Sendust powder, High Flux powder, MPP powder and silicon steel powder compositions recited in applicants' claim 2 are known (page 4, lines 5 to 9).

Tsukada '636 teaches it is known to use iron powders having a particle size of 75 to 200  $\mu\text{m}$  in the manufacture of cores (column 2, lines 42 to 46). The powder particle size disclosed by Tsukada '636 overlaps the powder particle size of 175  $\mu\text{m}$  or less recited in claim 1.

Mitani '706 teaches that it is known to use pure iron powder and Sendust powder having a particle size of 20 to 250  $\mu\text{m}$  to make cores (page 2, paragraph [0022]). The powder particle size disclosed by Mitani '706 overlaps the powder particle size of 175  $\mu\text{m}$  or less recited in claim 1.

Moro '280 teaches that it is known to use iron powder and Sendust having a particle size of 5 to 150  $\mu\text{m}$  to make cores (page 2, paragraph [0029]). The powder particle size disclosed by Moro '280 is encompassed by the powder particle size of 175  $\mu\text{m}$  or less recited in claim 1.

The claims and the admitted known prior art disclosed in the specification differ in that the admitted known prior art is silent with respect to the powder particle size and the dimensions of the core.

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However one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because each of Tsukada '636, Mitani '706 and Moro '280 teaches a powder particle size which at least overlaps the powder particle size recited in the claims and the use of such a powder to make cores, to use each of these powders disclosed by Tsukada '636, Mitani '706 and Moro '280 for its intended use is clearly taught by each of these secondary references.

The dimensions recited in the instant claims would have been obvious to one of ordinary skill in the art at the time the invention was made because the dimensions of the core are considered to be merely a matter of size of the core. The size of a product does not lend patentability to the claimed product, MPEP 2144.04 (IV)(A).

#### **IV. CHANGES IN SIZE, SHAPE, OR SEQUENCE OF ADDING INGREDIENTS**

##### ***A. Changes in Size/Proportion***

*In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package “of appreciable size and weight requiring handling by a lift truck” where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (“mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled.” 531 F.2d at 1053, 189 USPQ at 148.).

In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

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5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted known prior art disclosed in the specification at page 2, lines 5 to 32 and page 4, lines 5 to 9 in view of any one of Tsukada et al. (Tsukada '636, US Patent No. 5,800,636, cited by the Examiner), Mitani et al. (Mitani '706, US Patent Application Publication 2003/0047706, cited by the Examiner) or Moro (Moro '280 US Patent Application Publication No. 2002/0014280, cited by the Examiner) as applied to claims 1 and 2 above, and further in view of Japanese Patent Document No. 4-165607 (Japan '607, cited in the IDS submitted October 9, 2009).

The combination of the admitted known prior art disclosed in the specification at page 2, lines 5 to 32 and page 4, lines 5 to 9 in view of any one of Tsukada '636, Mitani Moro '280 teaches and is applied as set forth above.

Japan '607 teaches that it is known in the core art to combine individual cores using epoxy to form a larger core.

Claim 3 and the combination of the admitted known prior art disclosed in the specification at page 2, lines 5 to 32 and page 4, lines 5 to 9 in view of any one of Tsukada '636, Mitani Moro '280 differ in that the references are silent with respect to combining the individual cores.

However one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because Japan '607 teaches that it is a well known practice in the art to join individual cores.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (7:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Sheehan/  
Primary Examiner  
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JPS

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